

Serial No. 09/434,196
Filed November 4, 1999

REMARKS

Upon entry of the foregoing amendments, claims 1-6, 14, 16-19, 21-26 and 28-30 are pending in the application. Claim 20 has been cancelled. Claim 1 has been amended to recite an isolated composition. Support for the subject matter of amended claim 1 is found in the Examples and throughout the application as originally filed. Claims 2-6, 17, 21, 23, and 28 have been amended to provide for proper claim dependency. Support for the amended claims is found in the application as originally filed. Claims 14, 16, 18, and 19 have been amended for clarity. Support for the amended claims is found in the application as originally filed. Support for new claims 29-30 is found in the Examples and throughout the application as originally filed. Because the foregoing changes introduce no new matter, their entry is respectfully requested.

Rejections Under 35 U.S.C. §112, First Paragraph:

Claims 20 (and dependent claims 17, 21, 22 and 28) are rejected under 35 U.S.C. 112, second paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants have cancelled claim 20. Accordingly, Applicants respectfully request withdrawal of the outstanding rejection.

Rejections Under 35 U.S.C. §112, Second Paragraph:

Claims 14, 16 (and dependent claim 17) and 18-20 (and dependent claims 21, 22, and 28) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly

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point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that the claims are incomplete for omitting essential steps where such omission amounts to a gap between the steps. Examiner states that the omitted step is "(b) screening for altered activity" since there is no recitation step in the claims which indicates the nature of the activity or the manner in which the previous combining steps leads to an activity which can be measured.

Claims 14, 16, 18, and 19 have been amended to overcome the Examiner's rejections.

Claim 20 has been cancelled.

Applicant accordingly respectfully requests reconsideration and withdrawal of the outstanding rejections under U.S.C. 112, second paragraph rejections.

Rejections Under 35 U.S.C. §102(b)

Claims 1 (and dependent claims 4, 5, 23, and 26) stand rejected under 35 U.S.C. §102(b) as being anticipated by Park, et al.

Applicants have amended claim 1 to recite an isolated composition comprising a first single stranded nucleic acid, a second single stranded nucleic acid, wherein said first and second nucleic acids are complementary to each other, and at least one recombinant Rad52 protein from a higher eukaryote. Although *Park* discloses certain recombination activities which take place *in vivo* in monkey cells, the reference does not teach an isolated composition comprising a combination of nucleic acid and Rad52, as in the amended claims. Accordingly,

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the reference does not teach each and every limitation of the amended claims. Applicant therefore respectfully requests withdrawal of the outstanding rejection.

CONCLUSION

Applicants respectfully submit that claims are now in condition for allowance.


The Examiner is invited to call the undersigned attorney for discussion of any outstanding issues.

Respectfully submitted,

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